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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/394,228 09/13/99 PETKOVSEK

G P-99-012

QM32/0604

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EXAMINER

HENDERSON, M

ART UNIT

PAPER NUMBER

3722

DATE MAILED:

06/04/01

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.
09/394,228

Applicant(s)
Glenn Petkovsek

Examiner
Mark T. Henderson

Art Unit
3722



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 2, 2001
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-23 is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-9, 11, and 12 is/are rejected.
- 7) ☒ Claim(s) 5, 6, and 10 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on Apr 2, 2001 is: a) ☒ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXING of responses to Office Actions directly into the Group at (703)305-3579. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. The drawings have been amended to overcome the previous objections.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 7-9 and 11 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Walz (5,664,725).

Walz discloses in Fig. 1, 4 and 5, a label having a front side (A) and a backside (B) wherein the label (12) includes a postcard (70) and an integrally formed designator section (73) that is contained within the exterior sides (24a and 26a), a first and second anchor portion (58 and 59) having an adhesive (16) on the backside, and a backing strip (49) disposed over the adhesive on the backside of the anchor (seen in Fig. 5).

However, Walz does not disclose: a designator section indicative of a special service and has a machine readable code; and a label including shading and printing wherein the shading and printing are a single color.

In regards to **Claims 9 and 11**, the method for preparing a mailpiece for delivery is inherently taught by Walz.

In regards to **Claim 1, 7, 9 and 11**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have any desirable indicia in the designator section and postcard, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the

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present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate.

Also in regards to **Claim 1 and 9**, matters related to the choice of ornamentation (color and shading) producing no mechanical effect or advantage considered to constitute the invention are considered obvious and do not impart patentability, *In re Seid* 73 USPQ 431. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to integrally form the designator portion with the postcard, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

3. Claims 4 and 12 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Walz in view of Pekovsek (5,697,648).

Walz discloses in Fig. 1, 4 and 5, a mailing assembly comprising all the elements as set forth in claims 1 and 9, and as set forth above. Walz also discloses an associated backing sheet (14) attached to the backing strips (49) and the postcard (70).

However, Walz does not disclose a printer track strip associated (Webster Dictionary defines as “combined”) extending outside the exterior sides of the postcard wherein the strip includes a hole and is removably attached to the anchor portion.

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Petkovsek discloses in Fig. 5, a mailing assembly having a backing sheet (11) with a printer track strip (56) with holes (54) extending outside the exterior sides of the postcard (18) and is removably attached to the anchor portion (28)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Walz's mailing assembly by replacing the backing strip associated with the assembly with a backing strip containing a printer track strip as taught by Petkovsek for the purpose of allowing the mailing assembly to be passed through a printer.

Note, the examiner also submits that the patent reference (Petkovsek) is considered prior art because it had issued more than one year prior to the actual filing date (9/13/99) of the application and application claims 4 and 12 recite subject matter not supported by the parent patent (Petkovsek). Therefore, the claims are not entitled to a date earlier than the actual filing date of this application. See MPEP 2133.01.

Allowable Subject Matter

4. Claims 5, 6 and 10 are finally objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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5. Claims 13-23 are allowed.

6. The following is a statement of reasons for the indication of allowable subject matter: No prior art of record discloses or fairly suggests a mailing assembly comprising a plurality of labels removably attached and includes a postcard, a designator section, and a printer track strip associated with each label wherein the printer tracking strip includes a first hole and each label has a second hole.

Response to Arguments

7. Applicant's arguments filed on April 2, 2001 have been fully considered but they are not persuasive.

In response to applicant's argument that the Petkovsek and Walz references do not disclose a designator section within the exterior sides that define a postcard wherein the designator section is integrally formed with the return postcard, the examiner submits that both Petkovsek and Walz discloses a designator section in Fig. 1 as set forth in the above 103 rejections.

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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)305-3579. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

June 1, 2001



HENRY TSAI
PRIMARY EXAMINER

6/1/01